

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) : MASAKI
Serial No. : 10/772,078 **Art Unit** : 3735
Filed : February 3, 2004 **Examiner** : T. Shih
For : OPHTHALMOLOGIC APPARATUS

RESPONSE TO ELECTION OF SPECIES REQUIREMENT

MAIL STOP - Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Kindly consider the following election in response to the Election of Species
Requirement mailed April 16, 2007, in the above-identified application.

ELECTION

The Examiner, in the April 16, 2007 Election of Species Requirement, requires election of one of the following three patentably distinct species:

“Group 1, claim 1”;

“Group 2, claims 4- 5 and 8”; and

“Group 3, claim 9”.

The Examiner currently urges that no claim is generic.

Applicant respectfully traverses the above election of species requirement as being improper and requests withdrawal thereof.

Section 803 of the Manual of Patent Examining Procedure (MPEP) indicates that “there are two criteria for restriction between patentably distinct inventions” as follows (emphasis added) to wit:

- “(A) The inventions must be independent...; and,
- (B) There would be a serious burden on the examiner if restriction is not required....”

Applicant respectfully submits that Groups, or Species, 1-3 are properly presented in the same application and that no serious burden on the Examiner exists. The Examiner has not provided any evidence or line of reasoning to show that the identified Groups, or Species, are independent and that a serious burden would exists if restriction was not required. As such, the Examiner has not satisfied the two criteria identified in Section 803 of the MPEP.

Notwithstanding any actual independence or distinction between the identified Groups, or Species, Section 803 of the MPEP requires examiners to search and examine applications containing independent or distinct invention when no serious burden to do so exists. Section 803 of the MPEP also states that:

“If the search and examination of all of the claims can be made without serious burden, the examiner must examine them on the merits, even though it includes claims to independent or distinct inventions.”

The Examiner has not provided any specific discussion, line of reasoning, and/or evidence to support her conclusion that a serious burden, in fact, exists.

In view of the above discussion, it is respectfully submitted that the Election of Species Requirement is improper and should be withdrawn. Accordingly, action on the merits for Groups, or Species, 1-3, Claims 1, 4, 5, 8, and 9, is respectfully requested.

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Notwithstanding the above discussion, Applicant hereby elects the Species of Group 1, Claim 1, for examination on the merits. Applicant, nonetheless, reserves the right to file divisional applications based on the non-elected species and claims directed thereto.

AUTHORIZATIONS

The Commissioner is hereby authorized to charge any additional fees which may be required for the timely consideration of this amendment, or credit any overpayment to Deposit Account No. 13-4500, Order No. 1232-5273.

Respectfully submitted,
MORGAN & FINNEGAN, L.L.P.

Date: May 8, 2007

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